

REMARKS

Claims 1, 27, 28 and 30 have been amended to require that (a) the non-volatile silicone compound is present in an amount ranging from 1% to 85% by mass, based on the total mass of the composition; (b) a ratio by mass of said non-volatile silicone compound relative to said non-volatile hydrocarbon-based oil is greater than or equal to 1; or (c) both. Claim 13 has been amended to require the non-volatile silicone compound to be present in an amount ranging from 5% to 60% by mass, based on the total mass of the composition. Support for these amendments exists, *inter alia*, at page 8, line 26 through page 9, line 7.

New claims 45-48 have been added. Support for these new claims exists, *inter alia*, at page 8, line 26 through page 9, line 7.

Claims 1-48 are currently pending.

The Office Action rejected claims 1-44 under 35 U.S.C. § 103 as obvious over U.S. patent 5,948,394 (“Walling”) in view of U.S. patent 5,093,043 (“Jakobson”). In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of this rejection.

The Office Action admitted that Walling “does not teach expressly the particular percentages of each ingredient.” (Page 3). Accordingly, the claims have been amended to require that (a) the non-volatile silicone compound is present in an amount ranging from 1% to 85% by mass, based on the total mass of the composition; (b) a ratio by mass of said non-volatile silicone compound relative to said non-volatile hydrocarbon-based oil is greater than or equal to 1; or (c) both. More specifically, claims 13 and 45 require the presence of specific amounts of non-volatile silicone, and claims 20, 47 and 48 require the

presence of specific non-volatile silicone to non-volatile hydrocarbon ratios. Claim 46 requires both the presence of specific amounts of non-volatile silicone and the presence of specific non-volatile silicone to non-volatile hydrocarbon ratios.

These amendments set forth specific requirements for the presence of non-volatile silicone and/or specific requirements for the non-volatile silicone to non-volatile hydrocarbon ratio. As noted above, Walling “does not teach expressly the particular percentages of each ingredient.” Accordingly, Walling neither teaches nor suggests the claims as amended.

Walling generally discloses combining several different types of oils and waxes to form lipstick products. However, this teaching is so general that it provides no guidance whatsoever concerning which oils and waxes could be advantageously combined, let alone the specific concentrations and ratios in which to combine the oils and waxes. As a matter of law, such a general disclosure relating to the theoretical combination of any amount of hundreds or thousands of cosmetic ingredients cannot anticipate or render obvious the specific subject matter of the presently claimed invention. *See, In re Meyer*, 599 F.2d 1026 (CCPA 1979); *Akzo v. International Trade Comm'n*, 808 F.2d 1471 (Fed. Cir. 1986).

Walling completely fails to teach, suggest or recognize the importance of combining compounds having the specified solubility relationships set forth in the claims in the claimed amounts/ratios: that is, Walling would not lead one skilled in the art to combine a hydrocarbon-based oil and a non-volatile silicone compound which are both soluble/dispersible in a volatile hydrocarbon-based solvent yet incompatible with each other

Application No. 09/728,056
Response to Office Action dated January 27, 2005

in the claimed amounts/ratios. Walling contains no guidance whatsoever to make such a combination.

Clearly, Walling neither teaches nor suggests the claimed invention, and one skilled in the art following Walling's disclosure would not be led to the present invention.

Jakobson does not compensate for Walling's deficiencies. Jakobson is cited only for its disclosure related to diglyceryl diisostearate. Jakobson neither teaches, suggests, nor recognizes the importance of combining a hydrocarbon-based oil and a non-volatile silicone compound which are both soluble/dispersible in a volatile hydrocarbon-based solvent yet incompatible with each other in the claimed amounts/ratios.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejection.

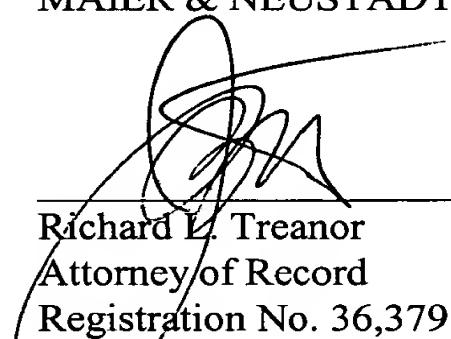
Application No. 09/728,056
Response to Office Action dated January 27, 2005

Applicant believes that the present application is in condition for allowance.

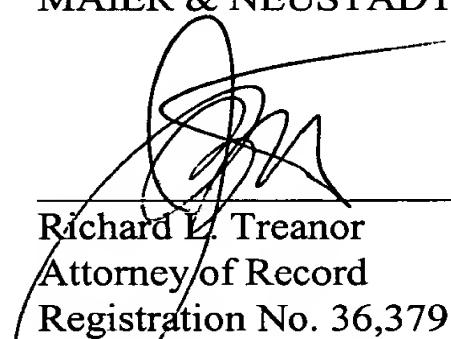
Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Richard L. Treanor
Attorney of Record
Registration No. 36,379



Jeffrey B. McIntyre
Registration No. 36,867

Customer Number

22850

Tel #: (703) 413-3000
Fax #: (703) 413-2220